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OFFICE OF PETITIONS

In re Application of :
Michael Palumbo, John Baross, and Mark P. :
Evans :
Application No. 10/750,362 :
Filed: December 31, 2003 :
Attorney Docket No. ATT/2003-0254 :
Title: METHOD AND SYSTEM FOR :
RECEIVING DIGITAL CONTENT USING A :
PREPAID DIGITAL CONTENT CARD :

DECISION ON PETITION

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed October 29, 2004².

On December 31, 2003, the application was deposited, identifying Michael Palumbo, John Baross, and Mark P. Evans as joint inventors. The application was deposited without an oath or declaration. On April 27, 2004, a "Notice to File Missing Parts of Nonprovisional Application – Filing Date Granted" (Notice) was mailed, indicating that the basic filing fee, an executed oath

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² The petition contains a certificate of mailing dated October 27, 2004.

or declaration, and a surcharge of \$130.00 were required. This Notice set a two-month period for reply.

Along with the instant petition, Petitioner has submitted the petition fee, the surcharge, the basic filing fee, and a four-month extension of time. Petitioner has also included a declaration that has been executed by each of the joint inventors save inventor Baross.

The petition has met requirements (1) – (3) and (5) above.

Regarding the fourth requirement, petitioner has not shown that a *complete* copy of the application was sent to the non-signing inventor. Petitioner has stated that only the declaration and the assignment were sent to the non-signing inventor. Petitioner has further included copies of an e-mail and a letter which were sent to the non-signing inventor, and both state that only the declaration and the assignment were enclosed. No mention is made of a copy of the application. Had the application been included, it seems that it would have been mentioned in the petition, the e-mail, and the letter. As such, it is clear that the Rule 47 applicant did not present the inventor with a copy of the entire application.

It follows that one cannot refuse to sign something which one has not been presented with. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed³.

For these reasons, the petition under 37 C.F.R. §1.47(A) is **DISMISSED**.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled “Renewed Petition Under 37 C.F.R. §1.47(a)”. This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

Any renewed petition may be submitted by mail⁴, hand-delivery⁵, or facsimile⁶.

³ In re Gray, 115 USPQ 80 (Comm’r Pat. 1956).

⁴ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence unless a Change of Correspondence Address Form (PTO/SB/122) is submitted for the above-identified application. A blank Change of Correspondence Address Form (PTO/SB/122) may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

The application file will be retained in the Office of Petitions for two (2) months.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
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Office of Petitions
United States Patent and Trademark Office

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5 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.
6 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.